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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,513	11/20/2001	Richard LaPeruta, JR.	PU010264	8631

7590 11/15/2004

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EXAMINER	
CLEVELAND, MICHAEL B	

ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/988,513	LAPERUTA, ET AL.	
	Examiner	Art Unit	
	Michael Cleveland	1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11/4/2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See attached*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See attached*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-16*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____.

Michael Cleveland
Primary Examiner
Art Unit: 1762

DETAILED ACTION

1. The proposed After Final amendment will not be entered because it raises new issues for further search and consideration, such as whether the claims have been changed or not. No changes are listed as currently amended, and no markings or cancellations appear. Accordingly, either the proposed amendment is non-compliant because it does not contain proper markings, or it does not alter the claims, in which case, it does not need to be entered.

Response to Arguments

2. Applicant's arguments filed 11/4/2004 have been fully considered but they are not persuasive.

Applicant argues that the reference fails to disclose the limitation of the final clause of claim 1 and of claim 3. The argument is unconvincing because it amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. That is, Applicant has not explained any alleged flaws in the Examiner's analysis that the reference teaches "removing the organic materials from the inner surface of the faceplate panel by volatilizing the organic materials through heating (col. 3, lines 14-22), which diffuse through holes in the aluminum layer faster than the gaseous decomposition products evolve (otherwise, blisters would form) (col. 3, lines 14-21; col. 2, lines 16-30)." and "The process must inherently have a rate of temperature increase (col. 3, lines 14-16) which necessarily determines the volume flow rates." Applicant points out that Giancaterini forms holes in the aluminum layer. However, this does not contradict the Examiner's position because it is this mechanism which Giancaterini uses to control of the diffusion rate.

Applicant argues that Giancaterini does not recognize or appreciate the importance of the constituents and particular thermal decomposition temperature of the material in preventing blister formation. The argument is unconvincing because they are not commensurate in scope with the claims which do not have limitations as to the constituents nor decomposition temperatures. Applicant argues that the final clause contains such limitations. The argument is incorrect because the final clause is not limited to any specific materials or temperatures (beyond organic materials and volatilization temperatures, both of which are clearly taught by Giancaterini), but rather to controlling a rate. Furthermore, Giancaterini recognizes that the

production of gas causes blistering and provides its holes so that the gas may diffuse out without causing blistering (i.e., at a greater rate than it is generated). Thus, Giancaterini inherently uses the claimed rate and therefore teaches controlling his process to use the claimed rate.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). However, the selection of something based on its known suitability for its intended use has been held to support a *prima facie* case of obviousness. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07. Saulnier teaches suitable coating weights for the layer of Giancaterini. Patel teaches suitable heating programs. Harper teachings improved adhesion by using its precoating layer.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Applicant argues that Patel does not teach heating to a first, second, and third temperature. The argument is unconvincing because heating to any temperature necessarily involves heating to at least two intermediate temperatures. Applicant states that this statement is incorrect. If Applicant maintains this position, Applicant is REQUIRED to explain how the temperature can be increased from one temperature to another temperature without passing

through at least two (in fact, an infinite number) of intermediate temperatures. Applicant argues that the reference fails to teach volatilizing the first component during the second temperature and the second component during the third temperature. The argument is unconvincing because the references teach volatilizing all of the organic components and that the volatilization is not an immediate process, and therefore any process which involves the gradual volatilization of two components by increasing the temperature necessarily meets the broad temperature and volatilization requirements of claim 11.

Applicant argues that Skinner does not teach providing the oxidizing agent elsewhere in the coating. The argument is unconvincing because it is incorrect. See col. 2, lines 41-48. Applicant argues that this passage only discloses the use in the funnel coating. The argument is entirely incorrect. By disclosing that use in the funnel coating is preferred, Skinner indicates the existence of less preferred embodiments which use the oxidizing agent in other locations.

Applicant argues that the references fail to teach the rates of claims 9-10. The argument is unconvincing because it has been held that the discovery of the optimum value of a result effective variable in a known process is ordinarily within the skill in the art. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cleveland whose telephone number is (571) 272-1418. The examiner can normally be reached on Monday-Thursday, 7-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Cleveland
Primary Examiner
Art Unit 1762

11/8/2004